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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/679,180 | 10/03/2003 | William L. Black | 2063.005800 | 2309 |

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| EXAMINER | |
|---|---|
| GILMAN, ALEXANDER | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2833 | |

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/679,180 | BLACK ET AL. | |
| | Examiner | Art Unit | |
| | Alexander D. Gilman | 2833 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *25 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

Prosecution on the merits of this application is reopened on claims 1-11 and 13-19, 21 are considered unpatentable for the reasons indicated below:

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 and 13-19, 21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 and 18-25 of copending Application No. 10/649,074. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The sole difference between the claim sets is the intended use. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See fn re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Since the claims do not express or imply a structural difference, they are not seen to be patentably distinct.

. Claims 1 , 8-12 are rejeded under 35 U.S.C. 102(e) as being anticipated by Rafert.

With regard to claim 1 , Rafert (US 6,497,659) discloses (Fig. 1 , 2, 3, 8, 14) dependent device (10), comprising:

an interconnect for a location at least one bus (12 or ) adapted to provide at least one bus signal to the location dependent device , and

a plurality of electrical contacts (24, 26 or 56, 58, 60) external to the location dependent device and capable of providing a signal indicative of a physical location of the location dependent device when the location dependent device is installed.

With regard to claim 8, Rafert discloses that at least one circuit element (22) deployed intermediate the first electrical contact and the at least one second electrical contact.

With regard to claims 9, 10, Rafert discloses that the at least one circuit element comprises at least one of a resistor (40), a capacitor (22), a voltage reference circuit, and a trace (406) having a selected resistance.

With regard to claims 11, 12, Rafert discloses control signal and a sensor.

Claims 1, 13, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Takagi et al

With regard to claims 1, 13 Takagi (US 6,441,748) discloses (Fig. 4, 1, 2) an interconnect for a location dependent device (1), comprising:

at least one bus (15, 16 ) adapted to provide at least one bus signal to the location dependent device , and

a plurality of electrical contacts ( contacts of 20) external to the location dependent device and capable of providing a signal indicative of a physical location of the location dependent device when the location dependent device is installed.

8. Claims 1- 6, 8, 11,13, 14, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Card, et al. this interconnect comprises a bus ala with a plurality of contacts connecting it to à device MC'. As noted

throughout the description, the pin connections are selected to provide a signal

(or address) indicative of the location of the device. It is noted that this device

is capable of being used for a location of dependent device as claimed. The device includes first and second contacts (see the various types in Figs. 3 and 40. In regard to claims 3 and 8, the first and second contacts are sockets (see Fig. 3).

. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Card. The use of solder is a well known alternative to pins/sockets and is used to assured continuous connections. For this reason, it would have been obvious to use soldered connections in place of the sockets of Card.

***Response to Arguments***

Applicant's arguments filed 10/17/2005 have been fully considered but they are not persuasive. Applicants argue that Takagi is completely silent with regard to any contacts present within the differential GPS tmits 20 and fails to teach or suggest a plurality of contacts capable of providing a signal indicative of a physical location of the location dependent device when the location dependent device is installed. as set forth in claims 1 and 13.

However, it is inherently that GPS units to properly function should have contacts capable of providing a signal (23) indicative of a physical location dependent device when the location dependent device is installed (Fig. 8 of Takagi et al).

Applicants argue that in Rafert the capacitor 22 (or other electrical circuit) indicates that the sensor associated with the capacitor 22 (or other electrical circuit) is connected, but it provides no indication of the physical location of the sensor.

It was interpreted that the capacitor 22 (or other electrical circuit) indicates that the specified sensor properly mated (not a different one). Hence the proper disposition of the sensor is confirmed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander D. Gilman whose telephone number is 571 272-2004. The examiner can normally be reached on Monday-Friday, 10:30 a.m. - 8:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571 272-2800 ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

02/23/2006

Alex Gilman

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